

REMARKS

Reconsideration of the present application is respectfully requested.

Claims 1-17 stand rejected under 35 U.S.C. § 103(a) based on U.S. Patent no. 6,169,911 of Wagner et al. ("Wagner").

Claims 1-17 are pending. Claims 3, 5, 11 and 13 have been canceled. Claims 1, 4, 9, 12, and 17 have been amended. No new matter has been added.

Applicants respectfully traverse the rejections. Independent claim 1 has been amended to incorporate into it the limitations of dependent claims 3 and 5. Independent claim 9 has been amended to incorporate into it the limitations of dependent claims 11 and 13 (now canceled). Similar amendment has been made to Independent claim 17.

The limitations added into the independent claims recite a specific manner of functional interaction between the body and the static area (or "first portion and "second portion") of the display in a mobile communication device, particularly, a specific manner in which the indicator is moved between the body and static area. An example of the recited functionality is described in detail in paragraph [0083] of Applicants' specification in conjunction with Figures 11A and 11B. Wagner does not disclose or even suggest such functionality, as admitted by the Examiner (Office Action, p. 2, in rejection of claims 4-5 and 12-13).

However, in rejecting claims 4-5 and 12-13 (now canceled), the Examiner takes "official notice" that "implementation of the step of automatically moving from the static area to the body was well known in the art", and contends that it would be obvious to

combine the (allegedly) “well-known implementations” with Wagner’s teaching. Applicants disagree. First, even if the Examiner’s official notice was proper (which it is not), the Examiner has only addressed the limitations of claims 4 and 12 in taking “official notice” but has not addressed the specific functionality recited in claims 5 and 13. Furthermore, official notice, if unsupported by documentary evidence, is only proper if the facts asserted to be well-known are capable of instant and unquestionable demonstration as being well-known. *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970). That is clearly not so in the present case. Applicants respectfully disagree that the functionality previously recited in claims 5 and 13 was well-known at the time the invention was made. Applicants request that the Examiner provide evidence that clearly supports the official notice or withdraw the rejection.

Therefore, independent claims 1, 9 and 17 and all claims which dependent on them are patentable over the cited art, for at least these reasons.

Furthermore, the claims were patentable over the cited art even before the above amendments. In the rejection of claims 1, 9 and 17, the Examiner admits that Wagner does not disclose “a storage having a browser stored therein, which . . . displays a mark-up language based screen . . . and operating a browser in the mobile communication device to access hypermedia content via a wireless network.” Office Action, p. 2. However, the Examiner takes “official notice” that “implementation of a mark-up language was well-known in the computer art.” The Examiner concludes that it would be obvious to combine the well-known implementation with Wagner’s teaching. The motivation, according to the Examiner, would be “to enhance the use of the Internet”. Office Action, p. 2.

The Examiner's statement of motivation ("to enhance the use of the Internet") is exactly the type of sweeping, overly general assertion that the courts have held to be inadequate to support an obviousness rejection. "[T]he showing [by the Examiner] must be clear and particular" findings of fact based on actual evidence, not merely broad conclusive statements. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999)(emphasis added). Furthermore, the Examiner's conclusion is clearly based on improper hindsight. Hindsight, while perhaps unavoidable to a limited extent (MPEP 2145), is not permissible when it is acquired from the applicant's disclosure. *In re McLaughlin* 443 F.2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971)). Here, the Examiner's conclusion of obviousness is clearly based on hindsight acquired solely from Applicants' disclosure.

For these additional reasons, therefore, independent claims 1, 9 and 17 and all claims which dependent on them are patentable over the cited art (and were patentable even prior to the above amendments).

Dependent Claims

In view of the above remarks, a specific discussion of the dependent claims is considered to be unnecessary. Therefore, Applicants' silence regarding any dependent claim is not to be interpreted as agreement with, or acquiescence to, the rejection of such claim or as waiving any argument regarding that claim.

Conclusion

For the foregoing reasons, the present application is believed to be in condition for allowance, and such action is earnestly requested.

If there are any additional charges, please charge Deposit Account No. 02-2666.

Respectfully submitted,

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